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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,721	03/22/2001	Carsten Andersen	5347.210-US	6030

25908 7590 08/13/2003

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NEW YORK, NY 10110

EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 08/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,721

Applicant(s)

ANDERSEN ET AL.

Examiner

Manjunath N. Rao, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claims 18-35 are currently at issue and are present for examination.

Applicants' amendments and arguments filed on 6-3-03, paper No.11, have been fully considered and are deemed to be persuasive to overcome the rejections previously applied.

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Terminal Disclaimer

The terminal disclaimer filed on 6-3-03 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,004,790 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 and claims 19-35 depending therefrom are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 is drawn to a variant CGTase which differs from a parent CGTase at several amino acid positions wherein the parent CGTase is Bacillus CGTase and wherein the amino acid positions corresponds to the amino acid position of the mature CGTase obtained from *B.circulans* strain 251. However, applicants do not identify a SEQ ID NO for the parent CGTase without which it would be impossible for the Examiner to do a search and compare the amino acid sequence information. Therefore Examiner urges

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applicants to provide the SEQ ID NO for the parent CGTase/s in order to perform a thorough search of the prior art.

Claims 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 19-21 recite the phrase "derived from a *Bacillus*". The metes and bounds of this phrase is not clear to the Examiner. Literally, while the term "derived" means "to isolate from or obtain from a source", the above term could also mean "to arrive at by reasoning i.e., to deduce or infer" or also mean "to produce or obtain from another substance". Therefore, it is not clear to the Examiner either from the specification or from the claims as to what applicants mean by the above phrase. It is not clear to the Examiner whether the "derived from a *Bacillus*" encompasses a single CGTase enzyme from each of the *Bacillus* species separately as in "isolated from" or whether it encompasses recombinants, variants and mutants of any CGTase of any bacteria, plant or animal or modified CGTase from any other source and labeled as "derived from a *Bacillus*". As applicants have not provided a definition for the above phrase, Examiner has interpreted the claims broadly to mean, that a "derived from a *Bacillus*" cDNA encompasses CGTases which are recombinants, variants, or mutants of any CGTase and not limited to those isolated specifically from *bacillus* sp. Examiner has given the same interpretation while considering the claims for all other rejections.

Claims 22-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention: Claims 22-31 recite the phrase "wherein the difference comprises". It is not clear to the Examiner as to what difference applicants are referring to. It appears applicants are referring to the "difference in amino acid positions". If this is so amending the claims accordingly would overcome this rejection.

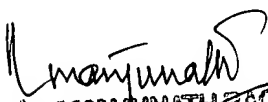
Conclusion

None of the claims are in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.


MANJUNATH N. RAO
PATENT EXAMINER

Manjunath N. Rao
August 11, 2003